

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICHOLAS MISCHENKO
and
KEITH A. GRONCZEWSKI

Appeal No. 96-3842
Application 08/489,696¹

ON BRIEF

Before ABRAMS, FRANKFORT and NASE, Administrative Patent
Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed June 12, 1995. According to appellants, the application is a continuation of Application 08/172,656, filed December 23, 1993, abandoned.

Appeal No. 96-3842
Application 08/489,696

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9, 12, 13, 16, 17 and 19, all of the claims remaining in the application. Claims 1 through 8, 10, 11, 14, 15 and 18 have been canceled.

Appellants' invention is directed to a dual beam electrical contact for making a connection on opposite sides of a dividing element through an aperture of said dividing element in an electronic device. Independent claims 9 and 13 are representative of the subject matter on appeal and a copy of those claims is attached to this decision.

The sole prior art reference relied upon by the examiner in rejecting the appealed claims is:

| | | |
|----------|-----------|---------------|
| Sterling | 3,551,750 | Dec. 29, 1970 |
|----------|-----------|---------------|

An additional reference (already of record) relied upon by this panel of the Board in a new rejection entered pursuant to 37 CFR § 1.196(b) is:

Appeal No. 96-3842
Application 08/489,696

Scheingold et al. (Scheingold) 4,052,118 Oct. 4, 1977

Claims 9, 12, 13, 16, 17 and 19 stand rejected under
35 U.S.C. § 102(b) as being anticipated by Sterling.

Rather than reiterate the examiner's full statement
of the above-noted rejection and the conflicting viewpoints
advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 17, mailed June 11, 1996) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 16, filed May 6, 1996) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of independent claim 9 under 35 U.S.C. § 102(b) as being anticipated by Sterling, we share the examiner's view that the dual beam contact (12) of Sterling (e.g., that seen in Figures 1-6, or that seen in Figure 10) includes a first contact beam (28) having a contact portion "adapted to be" positioned on a first side of a dividing element through an aperture to make a connection to a first

contact element on said first side of the dividing element; an elbow portion (26) integrally coupled to the first contact beam, with said elbow portion being "adapted to" extend through an aperture in a dividing element; a second contact beam (30) integrally coupled to the elbow portion, said second contact beam having a contact portion "adapted to" make a connection to a second contact element on a second side of the dividing element; and an attachment member (at the portion of 26 contacted by the retainer strip 33 of Sterling Figures 1-6, or at 46 in Figure 10 of Sterling) integrally associated with

at least one of said first and second contact beams to secure said dual beam contact within an electronic device.

Given that claim 9 on appeal is directed to a dual beam contact per se, appellants' argument (brief, pages 2-3) that the patent to Sterling does not show "an aperture through [a] dividing element" is of no moment, since claim 9 does not positively set forth such an aperture and since the contact (12) as seen in either Figures 1-6 or in Figure 10 of Sterling is clearly capable of being inserted through an appropriately sized aperture in a dividing element of an electronic device to make a connection on opposite sides of the dividing element as

inferentially set forth in claim 9 on appeal. Moreover, with particular regard to the contact seen in Figure 5 of Sterling, we note that if the insulator block (14) and the retainer strip (33) are together considered to be the "dividing element," then the contact (12) does include an elbow portion

(26) which extends through an aperture of the "dividing element" (i.e., between the block (14) and the retainer strip (33)) and, via the contact portions on arms (28) and (30), makes a connection on opposite sides of the dividing element.

Thus, since the spring contact member of either Figures 1-6 of Sterling or Figure 10 of Sterling includes all of the claimed structure of the "dual beam contact" set forth in appellants' claim 9 on appeal, we will sustain the examiner's rejection of claim 9 under 35 U.S.C. § 102(b) based on Sterling. Since the patentability of dependent claims 12 and 19 has not been separately argued by appellants, it follows that these claims will fall with claim 9 from which they depend.

Looking next at independent claim 13 on appeal, we note that this claim differs from claim 9 in that it requires the contact to include a first contact beam having "a distal end

portion adapted to be secured under a flange in said dividing element" and recites both first and second attachment members wherein the first attachment member is adapted to attach the dual beam contact to the dividing element "at said first side of said dividing element" and the second attachment member is adapted to attach the dual beam contact to the dividing element "at said second side of said dividing element." The examiner (answer, page 3), presumably referring to Figure 10 of Sterling, has taken the position that Sterling shows a first contact beam having "a distal end portion adapted to be secured under a flange in said dividing element" at (46) and first and second attachment members at (24) and (26). We do not agree. In the first place, the projection (46) of the dual beam contact seen in Figure 10 of Sterling is not "a distal end portion" of the first contact beam (28), but is instead the proximal portion of the first contact beam at or adjacent the elbow portion of the contact. Secondly, there is no indication in Sterling, or reason to conclude, that the intermediate portion (26) of the contact pointed to by the examiner and the side/top (24) of the block (14) in Figure 10

defines first and second attachment members which are capable of functioning in the manner set forth in appellants' claim

13. For these reasons, we will not sustain the examiner's rejection of

claim 13 under 35 U.S.C. § 102(b) based on Sterling. Since claims 16 and 17 depend from claim 13, it follows from the foregoing that we will also not sustain the examiner's rejection of those claims under 35 U.S.C. § 102(b) based on Sterling.

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against claims 9 and 19 on appeal.

Claims 9 and 19 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Scheingold. The dual beam contact (14), seen best in Figures 2 and 4 of Scheingold, includes a first contact beam (62b) having a contact portion (68) positioned on a first side of a dividing element (12) through an aperture (40) to make a connection to a first

Appeal No. 96-3842
Application 08/489,696

contact element (100) on said first side of said dividing element; an elbow portion (62a, 62c, 66) integrally coupled to the first contact beam, with said elbow portion extending through the aperture in the dividing element; a second contact beam (64) integrally coupled to the elbow portion, said second contact beam having a contact portion (78) making a connection to a second contact element (92) on a second side of said dividing element; and an attachment member (80, 86) integrally coupled with the second contact beam to secure said dual beam contact within the electronic device.

In summary, and as is apparent from the above determinations, the examiner's decision rejecting claims 9, 12, 13, 16, 17 and 19 under 35 U.S.C. § 102(b) as being anticipated by Sterling has been affirmed as to claims 9, 12 and 19, but reversed as to claims 13, 16 and 17. In addition, a new ground of rejection of claims 9 and 19 on appeal has been entered by this panel of the Board pursuant to 37 CFR §

Appeal No. 96-3842
Application 08/489,696

1.196(b). Thus, the decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

Appeal No. 96-3842
Application 08/489,696

ground of rejection to avoid termination of proceedings (37
CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141

or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the

Appeal No. 96-3842
Application 08/489,696

application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART, 37 CFR § 1.196(b)

| | | | |
|---------------|-----------------------------|---|-------------|
| | NEAL E. ABRAMS |) | |
| | Administrative Patent Judge |) | |
| | |) | |
| | |) | |
| | |) | BOARD OF |
| PATENT | |) | |
| | CHARLES E. FRANKFORT |) | APPEALS AND |
| | Administrative Patent Judge |) | |
| INTERFERENCES | |) | |
| | |) | |
| | |) | |
| | JEFFREY V. NASE |) | |
| | Administrative Patent Judge |) | |

psb

Appeal No. 96-3842
Application 08/489,696

Motorola, Inc.
Intellectual Property Department (JJK)
Corporate Offices
1303 E. Algonquin Road
Schaumburg, IL 60196

APPENDIX

9. A single piece, dual beam contact for making a connection on opposite sides of a dividing element through an aperture of said dividing element in an electronic device, the dual beam contact comprising:

a first contact beam having a contact portion adapted to be positioned on a first side of said dividing element through said aperture to make a connection to a first contact element of said electronic device on said first side of said dividing element;

an elbow portion integrally coupled to said first contact beam, said elbow portion being adapted to extend through said aperture in said dividing element;

a second contact beam integrally coupled to said elbow portion, said second contact beam having a contact portion adapted to make a connection to a second contact element of said electronic device on a second side of said dividing element; and

an attachment member integrally associated with at least one of said first and second contact beams of said dual beam contact to secure said dual beam contact within said electronic device.

13. A single piece, dual beam contact for making an electrical connection on opposite sides of a dividing element through an aperture of said dividing element in an electronic device, the dual beam contact comprising:

a first contact beam adapted to be positioned on a first side of said dividing element to make a connection to a first contact element of said electronic device on said first side of said dividing element, said first contact beam having a distal end portion adapted to be secured under a flange in said dividing element;

Appeal No. 96-3842
Application 08/489,696

a second contact beam adapted to be positioned through said aperture on a second side of said dividing element to make a connection to a second contact element on said second side of the dividing element;

an elbow portion coupled between said first contact beam and said second contact beam, said elbow portion being adapted to extend through said aperture in said dividing element to attach said dual beam contact to said dividing element;

a first attachment member adapted to attach said dual beam contact to said; [sic] dividing element at said first side of said dividing element; and

a second attachment member adapted to attach said dual beam contact to said dividing element at said second side of said dividing element.